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10/047,220	01/14/2002	J. Randolph Lewis	29488/38131	5743
4743 7590 12/10/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER SHAPIRO, JEFFERY A	
			ART UNIT 3653	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/047,220  
Filing Date: January 14, 2002  
Appellant(s): LEWIS, J. RANDOLPH

Michael P. Furmanek  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/23/08 appealing from the Office action mailed 12/28/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-3, 5-23, 39 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Elmsley et al in view of Boyd (US 6,208,908).

Elmsley discloses as follows.

As described in **Claims 1, 6, 11, 15, 21 and 43**;

- a. a bin (2) having a receiving end adapted to receive articles and a discharge end, defined by discharge flap (9), the bin having a dump mode, in which articles in the bin are discharged from the discharge end onto the collection area (10 and 11), and
- b. a pick mode, in which articles are retained in the bin, the bin being biased under force of gravity toward the dump mode;

See Elmsley, col. 2, lines 58-66.

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- c. a releasable latch (19) positioned to retain the bin in the pick mode against the force of gravity, the latch being responsive to a release signal to release the bin;
- e. wherein the bin automatically switches from the pick mode to the dump mode under the force of gravity thereby to discharge articles in the bin onto the collection area; See figure 3.
- k. a support shaft, wherein the bin is pivotally mounted on the support shaft, the bin having a center of gravity laterally offset from the support shaft so that the bin is biased to a dump position corresponding to the bin dump mode, the bin being rotatable to a pick position corresponding to the bin pick mode; See Elmsley, col. 2, lines 58-66.

Further regarding “b” above, it would have been obvious for one ordinarily skilled in the art to have biased the bin from either a level position or a tilted position, as the situation warranted, based on Elmsley’s teaching of biasing the bin using the weight of the bin itself as a force to move the bin to tilt and therefore dump its contents.

Boyd further discloses the following.

Regarding **Claims 7 and 22**, note that a weight attached to the bin near the discharge end to laterally shift the center of gravity of the bin toward the discharge end is considered to be equivalent to Elmsley’s “over-center” designed bins, in which the bins are biased such that their weight causes them to tip. See col. 2, lines 58-66.

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Regarding Claim 12, note that Elmsley's bins have bottom walls that are inclined when biased over-center.

Regarding Claim 13, note that Elmsley's bins have a top face formed at the top of the bin, that can be construed as being the upper surfaces to the four side walls.

Regarding Claim 39, note that Elmsley has first and second bins etc.

Regarding **Claims 1, 15 and 43**, Elmsley does not expressly disclose, but Boyd discloses

- d. a controller (18) operably coupled to the latch and having a processor programmed to generate the release signal to release the latch,
- f. wherein the collection area comprises a conveyor (138) and the processor is programmed to generate the release signal as a selected area of the conveyor passes the dumping station.

As described in **Claims 4, 9, 18 and 20**;

- i. the collection areas comprises a conveyor, and the processor is programmed to generate the release signal as a selected area of the conveyor passes the dumping station (see col. 3, lines 65-67 and col. 4, lines 1-19, noting that moving the dumping apparatus along the conveyor or moving the conveyor along towards a stationary dumping apparatus is considered to be functional equivalents of each other);

As described in **Claims 5 and 23**;

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j. a status indicator attached to the bin near the receiving end, the status indicator being movable between an active position, to provide a visual indication that more articles are to be placed in the bin, and an inactive position, to provide a visual indication that no more articles are to be placed in the bin (see figure 8 and operation box (112) as well as col. 9, lines 5-10);

As described in **Claims 8 and 17**;

m. a dump pedestal positioned to engage the bin in the dump position, and a pick pedestal positioned to engage the bin in the pick position, the pick pedestal carrying the releasable latch; See col. 7, lines 25-35, which mentions that discharging of articles from the interior of the bin may be accomplished in many ways. This teaching combined with Elmsley's teaching at col. 2, lines 58-66 would have led one ordinarily skilled to have used dump pedestals as they are functionally equivalent to Elmsley's "over-center action" of the bin.

As described in **Claim 14**;

w. the bin is manually placed in the pick mode.

See Boyd, col. 8, lines 62-64, which describes a manual operation. Note that it has been generally recognized that to automate a previously manual operation with the use of conventional control involves only routine skill in the art. *In re Venner*, 120 USPQ 193 (CCPA 1958).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have substituted a conveyor for Elmsley's collection tray (10) and bag (11), and to computerize Elmsley's system by incorporating a computer controlled latch to cause Elmsley's bins to automatically convert from a pick mode to a dump mode, as taught by Boyd.

The suggestion/motivation for converting Elmsley's system to a computerized version would have been to increase efficiency and throughput required by increased demand for products. See Boyd, col. 1, lines 26-32.

Regarding **Claims 2 and 16**, concerning the latch comprising an electromagnet, note that Boyd's latch mechanism is considered to be a functional equivalent to Applicant's. Also, Applicant's specification does not indicate the criticality of using this type of latch over other types of latches and that Boyd indicates at col. 7, lines 19-35 that any type of door control mechanism may be used with discharge member (32).

Regarding **Claims 3 and 19**, note that Boyd teaches assigning pick orders to the pick station. See Boyd, col. 2, lines 10-52, col. 7, lines 35-67 and col. 8, lines 1-36.

Regarding **Claim 10**, note that it would have been obvious in light of Elmsley, to have used either a front or rear or both front and rear flaps, as Elmsley discloses at col. 2, lines 58-66 that the bins are biased to tip in either left or right direction with respect to center.

#### **(10) Response to Argument**



3. Appellant's arguments filed 9/23/08 have been fully considered but they are not persuasive.

The recent decision rendered in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See recent Board decision *Ex Parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Regarding Independent Claims 1, 15 and 39, Appellant asserts that Emsley does not disclose "a bin comprising a receiving end, a discharge end, and an opening extending between the receiving and discharge ends." See Appellant's brief, p. 13, lines 16-18. In contrast, Emsley discloses a bin (2) with receiving end at the top, i.e., near element (2) leader line in figure 3, and a discharge end covered by lid (9), as illustrated in figure 3. The word "opening" as used in the claims, denote the "volume" between the receiving and discharge ends. The "volume" in Emsley's bin resides between the two ends. Emsley's two ends are at 90 degrees to each other, but are not precluded by the claim language.

Regarding Independent Claim 43, Appellant asserts that Emsley does not disclose "a bin having an open top and an open front in combination with various other features." See Appellant's brief, p. 15, lines 16-19. Again, note that Emsley's bin discloses an open top, i.e. located near element (2) leader line in figure 3, and an open front covered by lid (9).

Thus, Emsley, the primary reference relied upon, discloses a bin that meets Appellants' claim language as recited in the Independent Claims.

Regarding Boyd with respect to the rejection of Claims 1, 15, 39 and 43, note that Boyd is not used for its teaching of a bin having the features of "a bin comprising a receiving end, a discharge end, and an opening extending between the receiving and discharge ends." Boyd is used for its teaching of the details of a controller (18) and a collection area comprising a conveyor (138). Nonetheless, referring to Boyd's bin as illustrated in figure 4, the receiving end is at the top and the discharging end is at the bottom, with the "opening" or volume extending therebetween, with both ends longitudinally separated by the "opening" along a longitudinal line.

Further regarding Independent Claim 43, Appellant at p. 15, fourth line from the bottom, to p. 16, line 3 asserts that the reasoning used in the final rejection for modifying "Boyd" is "legally deficient". First, the final rejection at p. 6, lines 3-5 states

[t]he suggestion/motivation for converting Elmsley's system to a computerized version would have been to increase efficiency and throughput required by increased demand for products.

See Boyd, col. 1, lines 26-32.

It is submitted that "increasing efficiency and throughput required by increased demand for products" constitutes "articulated reasoning with a rational underpinning"

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that supports the conclusion of obviousness with respect to Elmsley's modification based upon the teaching of Boyd. This is because an increase in demand for products processed through Elmsley's system requires measures to be taken to modify Elmsley's system to produce more efficiency and throughput.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeffrey A. Shapiro/

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